**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Typed or Printed Name      Steven F. Godstein

Signature

Date      November 26, 2001

<b>PETITION UNDER 37 C.F.R. §1.47(A)</b>		Attorney Docket	2300-1624	#b
		First Named Inventor	Lewis T. Williams et al.	
		Application Number	09/803,719	
		Filing Date	March 9, 2001	
		Group Art Unit	1645	
		Examiner Name	Unassigned	
Address to:		Title	Human Genes and Gene Expression Products	

Sir:

As set forth in 37 CFR §1.47(a), if a joint inventor refuses to join in an application for patent, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor.

Applicants hereby petition to allow the joint inventors of the above-referenced patent application to make an application on behalf of themselves and on behalf of a joint inventor who refuses to join in an application. **In the instant case, the joint inventor Michael A. Innis has refused to sign.**

As required by 37 CFR §1.47(a), this petition is accompanied by:

- a) proof of the pertinent facts;
- b) the last known address of Michael A. Innis, the nonsigning inventor; and
- c) the fee set forth in 37 CFR §1.17(h).

**The Inventive Entity**

The above-identified application was filed in the names of:

1. Lewis T. Williams
2. Jaime Escobedo
3. Michael A. Innis
4. Pablo Dominquez Garcia
5. Julie Sudduth-Klinger

01/16/2002 BHMTEW 00000037 5000015 09803719  
06 FC:122 130.00 CH

- 6. Christoph Reinhard**
- 7. Filippo Randazzo**
- 8. Giulia C. Kennedy**
- 9. David Pot**
- 10. Altaf Kassam**
- 11. George Lamson**
- 12. Radoje Drmanac**
- 13. Radomir Crkvenjakov**
- 14. Mark Dickson**
- 15. Snezana Drmanac**
- 16. Ivan Labat**
- 17. Dena Leshkowitz**
- 18. David Kita**
- 19. Veronica Garcia**
- 20. Lee William Jones**
- 21. Birgit Stache-Crain**

The inventive entity set forth in the declaration submitted herewith names the following inventors:

- 1. Lewis T. Williams**
- 2. Jaime Escobedo**
- 3. Michael A. Innis**
- 4. Pablo Dominquez Garcia**
- 5. Julie Sudduth-Klinger**
- 6. Christoph Reinhard**
- 7. Filippo Randazzo**
- 8. Giulia C. Kennedy**
- 9. David Pot**
- 10. Altaf Kassam**
- 11. George Lamson**
- 12. Radoje Drmanac**
- 13. Mark Dickson**
- 14. Ivan Labat**
- 15. Lee William Jones**
- 16. Birgit Stache-Crain**

A Petition To Correct Inventorship Is Not Required

Applicants note for the record that a petition to correct inventorship is not required. The inventive entity identified at the time of filing of the application differs from that set forth in the executed declaration submitted herewith. The application was filed without an executed oath or declaration. As set forth in MPEP § 201.03 "Applications Filed Under 37 CFR 1.53(f) - No Oath/Declaration", since the application was filed after December 1, 1997, the actual inventorship of the application is to be taken from the executed oath or declaration as per 37 CFR 1.41(a)(1), and a petition to correct inventorship under 37 CFR §1.48(a) is not necessary as per 37 CFR §1.48(f).

All Available Joint Inventors Have Made a Declaration on Their Own Behalf as Required by 37 CFR §1.63 and On Behalf of the Nonsigning Inventor As Required by 37 CFR §1.64

As set forth in MPEP §403.03(a), all of the available joint inventors have (1) made a declaration on their own behalf as required by 37 CFR §1.63 and (2) made a declaration on behalf of the nonsigning joint inventor as required by 37 CFR §1.64.

The oath or declaration, which is submitted herewith, is signed by all the available joint inventors with the signature block of the nonsigning inventor left blank submitted herewith is to be treated as having been singed by all the available joint inventors on behalf of the nonsigning inventor.

Proof of the Pertinent Facts Under 37 CFR §1.47(a): The Co-Inventor Michael A. Innis Has Refused to Join in the Application

As set forth in MPEP §409.03(f), where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made.

To this end, we submit herewith the declaration of Nancy L. Swanson, the person to whom Michael A. Innis made the refusal to sign the application papers.

As established in Ms. Swanson's declaration:

- 1) a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to Michael A. Innis, the nonsigning inventor, for signature.
- 2) A copy of the application papers was sent to Michael A. Innis' last known address.
- 3) Michael A. Innis made an express written refusal to sign the application papers. Specifically, Mr. Innis indicated that he would not sign the declaration until

Chiron Corporation, a co-assignee of the above-referenced application and Mr. Innis' former employer, presented to Mr. Innis a consulting contract with acceptable terms. A copy of the document evidencing this refusal, an email from Mr. Innis to Ms. Swanson dated **November 20, 2001** is included with the declaration.

**Last Known Address of Michael A. Innis as Required by 37 CFR §1.47(a)**

The last known address of Michael A. Innis is:

**Michael A. Innis**  
315 Constance Place  
Moraga, CA 94556

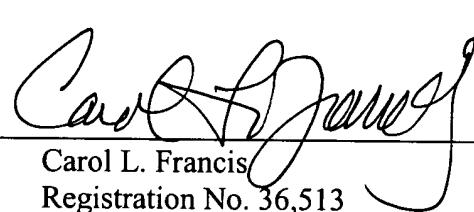
**Authorization to Charge Fees Required by 37 CFR §1.47(a) to Deposit Account**

This petition is being filed with a Petition for a Five-Month Extension of Time (to extend the period for response to the Notice to File Missing Parts to and including November 26, 2001, the first business day after the final due date of November 24, 2001), with authorization to charge our deposit account for the requisite fees, including the petition fee set forth in 37 CFR§1.17(h).

The Commissioner is hereby authorized to charge fees associated with the filing of this petition, and any additional fees which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-0815.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: November 26, 2001

By:   
Carol L. Francis  
Registration No. 36,513

**BOZICEVIC, FIELD & FRANCIS LLP**  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231  
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Atty Dkt. No.: 1624.002  
USSN: 09/803,719

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Typed or Printed Name

Steven F. Goldstein

Signature

*Steven F. Goldstein*

Date

November 26, 2001.

<p><b>DECLARATION BY NANCY L. SWANSON  REGARDING  PERTINENT FACTS RELATING TO DILIGENT EFFORT TO OBTAIN SIGNATURE OF JOINT INVENTOR WHO REFUSED TO SIGN APPLICATION PAPERS IN COMPLIANCE WITH 37 C.F.R. §1.63</b></p>	Attorney Docket	1624.002
	First Named Inventor	Lewis T. Williams
	Application Number	09/803,719
	Filing Date	March 9, 2001
	Group Art Unit	1645
	Examiner Name	Unassigned
	Title	Human Genes and Gene Expression Products

Sir:

I, Nancy L. Swanson, do hereby declare as follows:

I am a Patent Secretary in the Intellectual Property Department at Chiron Corporation. I am an assistant to Kimberlin L. Morley, who is Corporate Patent Counsel at Chiron Corporation. My official place of business is located at 4560 Horton Street, Emeryville, California.

I was directly involved in and/or supervised efforts to obtain the signature of Michael A. Innis of the application papers for U.S. Application Serial No. 09/803,719, filed March 9, 2001.

The pertinent facts are as follows:

- 1) **A *bona fide* attempt was made to present a copy of the application papers (specification, including claims and declaration) to Michael A. Innis, the nonsigning inventor, for signature.**

Specifically:

- a) I contacted Dr. Innis by email on October 18, 2001 to arrange for forwarding the application papers (copy attached).
- b) Dr. Innis replied by email on October 19, 2001 (copy attached). Dr. Innis indicated that he was traveling, but would be home around November 2 or 3, 2001.

Atty Dkt. No.: 1624.002

USSN: 09/803,719

2) A copy of the application papers was sent to Michael A. Innis' last known address.

I forwarded the application papers (specification, including claims and declaration) to Dr. Innis at his address at 315 Constance Place, Moraga, CA 94556 on November 12, 2001 by Federal Express. A copy of my letter that accompanied the application papers is attached.

3) Michael A. Innis made an express written refusal to me to sign the application papers.

On November 20, 2001 I received an email from Dr. Innis indicating that he would not sign the declaration included with the application papers until Chiron agreed to accept his consulting fee (copy attached). Specifically, Dr. Innis stated:

If and when you decide to accept my fee please send me a SIMPLIFIED [sic] agreement or even just an email. Then I shall review the patent and sign the declaration expeditiously including any comments I believe may be appropriate.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: November 26, 2001

By: Nancy L. Swanson  
Nancy L. Swanson  
Patent Secretary  
Assistant to Kimberlin L. Morley  
Corporate Patent Counsel  
Intellectual Property Department  
Chiron Corporation

Swanson, Nancy

From: Swanson, Nancy  
Sent: Thursday, October 18, 2001 11:25 AM  
To: 'innismar@aol.com'  
Subject: Signature Needed!

Mike:

I need to get your signature on two Declarations and Assignments for Hyseq/Chiron applications wherein you are a named inventor. If I sent the package to you via Federal Express, would it be possible for you to fax back the signed Declarations as we can submit faxed copies to the United States Patent Office? You can then return the originals for our safekeeping in a self-addressed Fed Ex envelope.

Thank you for your consideration.

Nancy

P.S. -- Katy gave me your email address

Nancy L. Swanson  
Patent Secretary  
Chiron Corporation  
Intellectual Property Dept.  
P.O. Box 8097  
Emeryville, CA 94662-8097  
(510) 923-2714 -- Direct Telephone Number  
(510) 655-3542 -- Facsimile Number  
e-mail: nancy\_swanson@chiron.com

**Swanson, Nancy**

**From:** InnisMA@aol.com  
**Sent:** Friday, October 19, 2001 7:36 AM  
**To:** Swanson, Nancy  
**Subject:** Re: Signature Needed!

Nancy,

I have been on the road for 6 weeks. We are traveling by motorcycles and have been to Nova Scotia, New England, Down the outer banks to Savannah, New Orleans. Today we are in the Ozarks. Don't know where we will be staying each night until we reach return home around Nov 2 or 3. Is that soon enough?

Michael Innis  
Cell Phone 925-890-8491



CHIRON



Chiron Corporation  
4560 Horton Street  
Emeryville, California 94608-2917  
510.655.8730  
Intellectual Property Fax: 510.655.3542  
Mailing: P.O. Box 8097  
Emeryville, California 94662-8097

**Intellectual Property**

November 12, 2001

Michael A. Innis  
315 Constance Place  
Moraga, CA 94556

Re: U.S. Patent Application No. 09/803,719  
for Human Genes and Gene Expression Products  
Our Reference No.: PP-01624.002

Dear Mike:

While you were employed at Chiron Corporation, you were named as an inventor on the above-identified patent application. The patent application is currently being prosecuted by the U.S. Patent and Trademark Office.

A serial number now has been assigned to the case, and Chiron must submit (1) a declaration and (2) an assignment with your signature. The declaration states that you have read the case and that you confirm that you are an inventor.

The declaration also states that as an inventor, you will inform the U.S. Patent Office of any publications or disclosures that may affect the patentability of the claimed invention. For our evaluation, please notify the Patent Department of the following:

- (a) relevant publications or patents published before your application was filed;
- (b) manuscripts that you prepare and publish on this and related work, before and after the application was filed; and
- (c) new data relevant to the application that is generated after the filing date.

Remember this application is a confidential document. It will not be published until 6 months after any foreign filing. Please do not refer to this application in any documents that will be circulated outside of Chiron, such as your CV.

November 12, 2001  
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Therefore, enclosed are the following documents:

1. Copy of Patent Application (Please keep for your records).
2. Assignment. TWO separate Assignments (one assignment for the provisional, which the utility application is claiming priority from) to be signed and dated by you (in blue ink) and signed by someone watching you sign document. DOES NOT NEED TO BE NOTARIZED. Attached to each assignment form is \$1.00 in consideration of your assigning your rights to the patent to Chiron as you agreed to do when you began working at Chiron. (Return signed Assignments). If you make any changes, please initial and date changes.
3. Declaration. Please sign and date in blue ink. This document need not be notarized. Return the original signed Declaration. If you make any changes, please initial and date changes.
4. A self-addressed Federal Express envelope to return documents. Just date and drop in FedEx box -- the envelope is prepaid.

Thank you for very much for your help in this matter. If you have any questions regarding the above, please do not hesitate to contact Kimberlin L. Morley, Corporate Patent Counsel.

Sincerely,

  
Nancy L. Swanson  
Assistant to Kimberlin L. Morley

Encls.



**From:** "Swanson, Nancy" <Nancy\_Swanson@chiron.com>  
**To:** "Steven Goldstein (E-mail)" <Goldstein@bozpat.com>  
**Date:** 11/26/01 1:59PM  
**Subject:** MIKE INNIS: 11/20/01



FYI

-----Original Message-----

From: MICHAEL INNIS [mailto:innismj@pacbell.net]  
Sent: Tuesday, November 20, 2001 6:24 PM  
To: Estrada, Ryan  
Cc: Morley, Kimberlin; Swanson, Nancy  
Subject: Re: Consulting Agreement  
Importance: High

Ryan, Kimberlin and Nancy:

I am insulted by the contents and length of this "Consulting Agreement," especially as I am the principle inventor of the listed patent. Ryan, FYI I retired from Chiron two years ago after 20 years of dedicated, loyal service; at that time I offered Chiron an opportunity to retain me as a patent consultant, especially for the Berlex/Biogen litigation, but also for this and other areas which are my expertise. For reasons unknown to me, Chiron decided to treat me with hostility instead. I am not presently employed nor have I considered seeking employment during the past 2 years.

I told Kimberly via voice mail last week that my consulting fee is 2500/day. This was not up for negotiation. If and when you decide to accept my fee please send me a SIMPLEFIED agreement or even just an email. Then I shall review the patent and sign the declaration expeditiously including any comments I believe may be appropriate. I am sending the patent assignments back to Chiron today because my previous Cetus employment agreement included assigning patents to the company for \$1.00 compensation.

Michael

> Dear Dr. Innis  
> Per Kim Morley's request, attached is a Consulting Agreement  
> outlining the terms and conditions under which you will provide certain  
> consulting services to Chiron. If you find the agreement acceptable,  
> please  
> print out the agreement, sign it, and then fax it back to my attention. If  
> you have any questions or concerns regarding this agreement, please feel  
> free to contact me.  
>  
> Best wishes,  
> Ryan Estrada  
> Contract Associate  
> Law Department  
> Phone: 510-923-3524  
> Fax: 510-654-5360  
>  
>  
> <<innis.doc>>  
>

